05/21/02

Hearing:
March 26, 2002

Paper No. 12
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Mainline Technology, Inc.

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Serial No. 75/467,081

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Marshall G. MacFarlane of Young & Basile, P.C.
for Mainline Technology, Inc.

Marc J. Leipzig, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

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Before Hohein, Wendel and Bottorff, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Mainline Technology, Inc. has filed an application to register the mark DOTS for "medical diagnostic test kits for detecting the presence of bacterial infection, said kits consisting primarily of developer solution, control

plasma, pipettes, swabs, coated test strips and medical diagnostic reagents."[1]

Registration has been finally refused under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the mark QUIK-DOT which is registered for "medical diagnostic test kits including biochemical reagents."[2]

The refusal has been appealed. Both applicant and the Examining Attorney have filed briefs and both participated in the oral hearing.

We make our determination of likelihood of confusion on the basis of those of the *du Pont*[3] factors that are relevant in view of the evidence of record. Two key considerations in any *du Pont* analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods with which the marks are being used, or are intended to be used. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); In re Azteca Restaurant Enterprises, Inc., 50 USPQ2d 1209 (TTAB 1999).

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[1] Serial No. 75/467,081, filed April 13, 1998, based on an allegation of a bona fide intention to use the mark in commerce.
[2] Registration No. 1,522,374, issued January 31, 1989, Section 8 & 15 affidavits accepted and acknowledged, respectively.
[3] In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Looking first to the respective goods, we find that applicant's medical diagnostic test kits designed specifically for the detection of bacterial infection fall squarely within the scope of registrant's "medical diagnostic test kits." In addition, both contain reagents for carrying out these diagnoses. Applicant has in fact conceded the similarity of the goods. For purposes of our analysis of likelihood of confusion, we consider the goods to be legally identical.

Furthermore, in view of identical nature of the goods, we must assume that the goods of both applicant and registrant would travel in the same channels of trade and would be available to the same class of purchasers. There are no limitations in the application or registration which would imply otherwise. See Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Thus, the factor which is the primary focus in our analysis is the similarity or dissimilarity of the respective marks, DOTS and QUIK-DOT. In making our comparison, we are guided by the general principle that the greater the similarity of the goods, the lesser the degree of similarity of the marks which is necessary to support a conclusion that there will be a likelihood of confusion.

See Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1985).

The Examining Attorney takes the position that both registrant and applicant use the same dominant term "DOT" in their marks and thus the overall commercial impressions created by the marks are highly similar. Applicant, on the other hand, argues that the marks differ not only in appearance and sound, but also in connotation and, as a result, in commercial impression. Applicant insists that in the field of medical diagnostics DOTS would connote "the appearance of bacterial colonies on a substrate," whereas QUIK-DOT would connote "the rapid appearance of a single indicator mark." (Brief p. 4). Applicant further argues that it is just as reasonable to conclude that "QUIK" is the dominant element of registrant's mark, in view of its being the first and longest term in the mark.

While the marks must be considered in their entireties, there is nothing improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Although descriptive matter cannot be ignored in comparing the marks, it is also a fact that consumers are more likely to rely on the non-descriptive portion of a mark as an

indication of source. See Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993).

There are obvious differences in the appearance and sound in the marks DOTS and QUIK-DOT, stemming from the additional presence of the term "QUIK" in registrant's mark. Nonetheless, we agree with the Examining Attorney that the term "DOT" dominates each of the marks, resulting in similar overall commercial impressions for the two marks when considered in their entireties. The term "QUIK" is at the very least suggestive, if not descriptive, of the rapid functioning of the diagnostic kits and would have little significance as an indication of the particular source of the kits. Any distinction which might be made between QUIK-DOT and DOTS on the basis of the term "QUIK" is more likely to be on the basis of the speed with which the particular kits perform the diagnostic tests, rather than the source of the kits.

We find the differences which applicant argues in the connotations of the two marks a bit strained and not differences which would be readily apparent to the purchasers of these diagnostic kits. In the first place, as previously pointed out, the goods on which the marks are found may be identical in function or purpose, and thus any differences in connotation related to the number or

type of indicator marks would be totally inapplicable. Furthermore, even though the purchasers of these kits may be medical personnel or purchasing personnel in a medical facility, the distinction between the singular DOT and the plural DOTS is not one which is likely to be noted, or if noted, remembered over a period of time. The comparison of the marks cannot be made on a side-by-side basis, but rather on the general impressions created by the marks in the minds of these purchasers as they come upon the marks at different points in time. See Mother's Restaurants Inc. v. Mother's Other Kitchen, Inc., 218 USPQ 1046 (TTAB 1983). Under this analysis, the marks as a whole create similar overall commercial impressions.

Although applicant attempts to draw a parallel here to the marks involved in two other cases, In re N.A.D., Inc., 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985) and In re Digirad Corp., 45 USPQ2d 1841 (TTAB 1998), we would point out that likelihood of confusion is determined on a case-specific basis, using the *du Pont* factors which are relevant as our guide. See Han Beauty Inc. v. Alberto-Culver Co., 236 F.2d 1333, 57 USPQ2d 1557 (Fed. Cir. 2001). Even if we were to consider these other cases, the factors having the greatest weight therein were much different from the ones involved here. In the *N.A.D.* case a consent

agreement played a major part in the Court's determination of no likelihood of confusion. We have no such agreement here. In the *Digirad* case, the Board found that, even if the goods were sold under identical or similar marks, an insufficient relationship had been established between the goods to find confusion likely. Here the goods have been found to be legally identical. The present circumstances cannot be likened to the prior cases.

Applicant further argues that registrant's mark QUIK-DOT must be put in the category of a weak mark, both because of its "descriptive connotation" and because of the use by others of the term "DOT" or "QUIK" (or the correctly spelled form QUICK) in registered marks. While we would agree that the term "QUIK" has suggestive significance when used in connection with a diagnostic test, we cannot entertain any contention that registrant's mark as a whole is descriptive. An allegation of that nature constitutes a collateral attack on the validity of registrant's registration, which is not permitted in an ex parte proceeding. See In re Calgon Corp., 435 F.2d 596, 168 USPQ 278 (CCPA 1971; In re Peebles Inc., 23 USPQ2d 1795 (TTAB 1992). Nor do we have any reason for concluding that registrant's mark is a weak mark, based on use of similar marks by others on similar goods. The registrations which

applicant mentions have not even been described as to the specific marks or goods and/or services involved, much less properly made of record by providing copies thereof. See In re Duofold, 184 USPQ 638 (TTAB 1974). We can give unidentified registrations no consideration whatsoever. Even if properly made of record, third-party registrations are not evidence of actual use of the marks or public familiarity with the marks so as to be accustomed to the existence of similar marks in the marketplace. See Smith Bros. Mfg. Co. v. Stone Mfg. Co., 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); Hilson Research Inc. v. Society for Human Resource Management, *supra.* Applicant has made no evidence of record to support its contention that registrant's mark is weak in the medical diagnostic field or that it is entitled to less than the full scope of protection afforded a registered mark.

Applicant also raises for consideration the factor that the purchasers of these diagnostic test kits would be sophisticated professionals in the medical field. Assuming this to be true, purchasers of this level of expertise are not immune to source confusion. This is especially true when the marks involved are highly similar in commercial impression, as is the case here, and the goods on which the marks are used are essentially the same. See Aries Systems

Corp. v. World Book Inc., 23 USPQ2d 1742 (TTAB 1992). Moreover, the goods at issue here are not highly expensive medical apparatus which would entail a great deal of forethought or care in making a selection thereof, but rather are fairly simple diagnostic test kits which, by applicant's own description, are sold in bulk.

Finally, applicant argues that the Examining Attorney has produced no evidence of actual confusion. Needless to say, since applicant's application is based on an intent to use the mark, rather than actual use, evidence of actual confusion may be hard to come by. The question arises as to whether there has been any real opportunity for confusion. Moreover, the burden would be on applicant to show that there has been appreciable use by applicant of its mark for a significant period of time in the same general market areas as registrant with no instances of actual confusion. See Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768 (TTAB 1992). In any event, the test under Section 2(d) is likelihood of confusion, not actual confusion.

Accordingly, in view of the legal identity of the goods, the identity of the channels of trade, and the highly similar overall commercial impressions created by the marks, we find confusion likely.

Decision: The refusal to register under Section 2(d) is affirmed.